

Applicant: Marks de Chabris et al.
Application No.: 09/770,108

REMARKS

Claims 1 and 4-27 are currently pending in this application. Based on the confusion noted in the May 11, 2004 and March 11, 2005 Office Actions, Applicants' have summarized the events leading up to the current Reply below.

On May 11, 2004, a non-final Office Action issued in which stated that claims 1, 10, 16 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite, claims "1-21" and 22-27 were rejected under 35 U.S.C. §101 as non statutory, and claims 1 and "5-27" were rejected under 35 U.S.C. §103(a) as being unpatentable over Ordish et al. in view of Buist.

On October 12, 2004, Applicants filed a response to the non-final Office Action noting that the May 11, 2004 Office Action incorrectly stated that claims 1 and 5-27 are currently pending in this application, when it should have stated that claims 1 and 4-27 are currently pending in this application. In addition, claims 1, 10-22 were amended to attempt to overcome the indefiniteness and non-statutory rejections, and independent claims 1, 10, 16, and 22 were further amended in attempt to define the claimed invention over the cited prior art.

On March 11, 2005, a non-final office action issued which was intended to be a re-issue of the May 11, 2004 Office Action in order to correct the errors in that Office Action. The March 11, 2005 Office Action issued in essentially the same manner as the May 11, 2004 Office Action, with the exception that the previous indefiniteness rejections were withdrawn.

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On April 5, 2005, the undersigned attorney for Applicants contacted Examiner Bashore via telephone to discuss the following errors in the March 11, 2005 Office Action:

- 1) Paragraph 2 (pg. 2) of the Office Action states, "[c]laims 1-21 are rejected under 35 U.S.C. 101 ...", which is incorrect because claims 2 and 3 of the present application were previously cancelled
- 2) Paragraph 2 (pg. 2) of the Office Action further states, "[t]he terms 'communications network', 'heuristic', 'data storage means', 'schedule supervisor means', 'transaction supervisor', all are not solely by computer." Pursuant to Applicant's October 12, 2004 Reply, the terms "data storage means" and "schedule supervisor means" are no longer recited in the claims. Furthermore, the term "transaction supervisor" was amended to recite either "transaction supervisor software" (claims 10 and 11) or "transaction supervisor server" (claims 16 and 17) and is no longer recited in the claims.

Based on these errors, Examiner Bashore stated that Applicants should not respond to the March 11, 2005 Office Action, and that he would withdraw the March 11, 2005 Office Action and issue a new Office Action to correct these errors. Applicants' filed a Summary of the April 5, 2005 Telephonic Interview on May 2, 2005, which was followed by a non-substantive Reply filed on June 9, 2005 to confirm that the March 11, 2005 would be withdrawn and that no substantive response was required.

The present Office Action issued on August 23, 2005 as a non-final Office Action and is stated to be a re-issue of the March 11, 2005 Office Action. In the present Office Action, claims 1 and 4-21 are rejected under 35 U.S.C. § 101 as being non-statutory, and claims 1 and 4-21 are also rejected under 35 U.S.C. § 103(a) as

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being unpatentable over U.S. Patent No. 5,727,165 (Ordish) in view of U.S. Patent No. 6,408,282 (Buist).

Response To Claim Rejections

1. Claim Rejections - 35 USC § 101

Claims 1 and 4-21 have been rejected under 35 U.S.C. § 101 as being non-statutory under the assertion that these claims as presented do not claim a technological basis. In particular, the Office Action states, "[t]he terms 'communications network', 'heuristic', 'data storage means', 'schedule supervisor means', 'transaction supervisor', all are not solely by computer." This rejection is substantively identical to the rejection set forth in the May 11, 2004 Office Action, and does not appear to take into consideration Applicants' claim amendments and remarks filed on October 12, 2004.

Applicants initially note that the terms "data storage means," "schedule supervisor means," and "transaction supervisor" are no longer recited in the claims. Pursuant to Applicant's October 12, 2004 Reply, the term "data storage means" was amended in claim 10 to recite "data storage," the term "schedule supervisor means" was amended in claims 10 and 11 to recite "schedule supervisor software, and the term "transaction supervisor" was amended in claims 10 and 11 to recite "transaction supervisor software" and in claims 16 and 17 to recite "transaction supervisor server."

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Furthermore, Applicants respectfully submit that based on the amendments made in the October 12, 2004 Reply, independent claims 1, 10, and 16 distinctly claim a technological basis. Specifically, the method of claim 1 is implemented on a computer. Claim 10 recites a system for implementing the claimed method on a computer; the system including data storage, schedule supervisor software and transaction supervisor software. Claim 16 relates to a *system* comprising a database server, a schedule supervisor server and a transaction supervisor server. Accordingly, Applicants respectfully request that the §101 rejections of claims 1 and 4-21 be withdrawn.

2. *Claim Rejections - 35 USC § 103(a)*

Claims 1 and 4-21 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,727,165 (Ordish) in view of U.S. Patent No. 6,408,282 (Buist). This rejection is substantively identical to the rejection set forth in the May 11, 2004 Office Action, and does not appear to take into consideration Applicants' amendments and remarks filed on October 12, 2004. Applicants respectfully traverse this rejection for the reasons set forth in the October 12, 2004 Reply which are substantially reproduced below.

Independent claim 1 recites a method of coordinating and timing orders using an order manager operating on a computer. The order manager is capable of communicating with a transaction destination over a communication network. The method as claimed involves the steps of:

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- a) receiving an order definition at the order manager, the order definition defined by an evaluation heuristic identifying a plurality of transaction instances, each said transaction instance identifying an order, the transaction destination and a predefined time instant for execution of the order with the transaction destination;
- b) at the predefined time instant associated with one of the transaction instances, transmitting over the communications network to the associated transaction destination an order message identifying the associated order; the predefined time instant, the order and the transaction destination of the order message being determined in accordance with the evaluation heuristic;
- c) receiving from the associated transaction destination over the communications network a completion message identifying a completion status of the order at the transmitted transaction destination; and
- d) repeating steps b) and c) in accordance with the completion status and the evaluation heuristic to coordinate and time the order.

The Examiner asserted that the recitation of a transaction destination and a time instant for the order is inherent from Ordish because electronic communication has destinations and time instances *per se*. Regardless, Applicants submit that Ordish does not disclose using an order definition comprising a plurality of transaction instances, wherein each said transaction instance identifies an order, the transaction destination and a predefined time instant for execution of the order with the transaction destination.

The Examiner also asserted that it would have been obvious to update or revise an order because Buist teaches a continual change in market condition. However, Buist does not disclose repeatedly placing orders at predefined times in accordance with a heuristic by transmitting order messages defined by a common

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order definition, and receiving completion messages identifying the completion status of each order, as required by claim 1, paragraph (d).

In addition, the Examiner indicated that it would have been obvious to transmit at time instances associated with one of the transaction instances because Buist teaches a need to transact after normal market hours. While Buist teaches the need to transact after normal market hours, Buist does not teach transmitting an order to a transaction destination at a predefined time instance in accordance with an evaluation heuristic.

As recited in the claims, the order message identifying the associated order is transmitted to the associated destination at the *predefined* time instant associated with the transaction instance. In addition, the order and the transaction destination of the order message are determined in accordance with the evaluation heuristic. Accordingly, the present invention can automatically modify orders and destinations in accordance with the evaluation heuristic at predefined time instances, which can provide a significant advantage over the prior art. Neither Ordish nor Buist, either alone or in combination, teach or suggest these features.

Because claims 4 to 9 depend upon independent claim 1, the foregoing also applies to the invention recited in those claims. In addition, the aforementioned characteristics that distinguish claim 1 of the present invention over the prior art equally apply to distinguish apparatus claims 10-27 over the cited prior art.

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Accordingly, Applicants respectfully request that the §103(a) rejections of claims 1 and 4-27 be withdrawn.

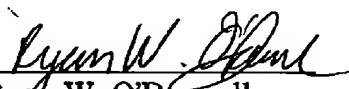
Conclusion

If the Examiner believes that any additional minor formal matters need to be addressed in order to place this application in condition for allowance, or that a telephone interview will help to materially advance the prosecution of this application, the Examiner is invited to contact the undersigned by telephone at the Examiner's convenience.

In view of the foregoing remarks, Applicants respectfully submit that the present application, including claims 1 and 4-27, is in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

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Enclosure